

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR919960186US2

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on _____

Signature _____

Typed or printed name _____

Application Number

10/066,171

Filed

March 26, 2009

First Named Inventor

Brian S. Beaman

Art Unit

1795

Examiner

William T. Leader

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Daniel P. Morris/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Daniel P. Morris

Typed or printed name

☒ attorney or agent of record. 32,053
Registration number _____

914-945-3217

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

March 26, 20009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.5. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Applicants:

Date: March 26, 2009

Brian S. Beaman et al.

Group Art Unit: 2829

Serial No.: 10/066,171

Examiner: William T. Leader

Filed: February 1, 2002

Docket No.: YOR919960186US2

For: PROBE STRUCTURE HAVING A PLURALITY OF DISCRETE INSULATED
PROBE TIPS PROJECTING FROM A SUPPORT SURFACE, APPARATUS FOR USE
THEREOF AND METHODS OF FABRICATION THEREOF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

This Pre-Appeal Brief is submitted in response to the Final Office Action dated November 26, 2008, please consider the following:

ARGUMENT

Claim Rejections - 35 USC §102

Claims 49, 81, 90, 91 and 96 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al (US 6,110,823). Applicants respectfully disagree and request reversal of this rejection. Eldridge et al. is not prior art under 35 USC 102 as described below. Thus the Examiner has not made out a prima facie case of anticipation by Eldridge et al.

Claim Rejections - 35 USC §103

Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (US 6,110,823) in view of Saruwatari et al (US 5,233,011). Applicants respectfully disagree and request reversal of this rejection. Eldridge et al. is not prior art under 35 USC as described below. The Examiner identifies no teaching in Saruwatari by which a dielectric coating can be formed on an elongated electrical conductor for which each of said first ends are bonded "to said surface so that said second ends are disposed away from said surface," and "forming a dielectric coating on said elongated electrical conductors" as recited in claims 49 from which claim 66 depends. Thus the Examiner has not made out a prima facie case of obviousness.

Claims 86, 88 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (US 6,110,823) in view of Nakata et al (US 5,665,610). Applicants respectfully disagree and request reversal of this rejection. Eldridge et al. is not prior art under 35 USC as described below and thus the Examiner has not made out a prima facie case of obviousness.

Examiner's Response to Applicants' Arguments

The Final Action (OA) states:

Applicant's arguments filed April 3, 2006, have been fully considered but they are not persuasive. At page 21 of the response, applicant argues that Eldridge has no teaching of any

method of forming a dielectric coating on elongated conductors. As pointed out in the previous office action, such a teaching is found in figure 10K... A layer of dielectric material (1094) is applied to flexible, elongated wire 1086 (column 67, lines 55-59).

Eldridge Col 67, lines 55-59, states:

A layer 1094 of dielectric material (such as silicon dioxide) is applied over the nickel layer 1092. The dielectric material (1094) may encompass (not shown) the contact pad 1088 to assist in anchoring the wire stem thereto.

Eldridge Col 67, lines 55-59, provides no teaching of how the dielectric material can be applied over the nickel layer 1092. Thus there is no enablement for this process and consequently no enablement for the structure of Eldridge figure 10k.

MPEP Section 2121.01 entitled "Use of Prior Art in Rejections Where Operability Is in Question" states:

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'" *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; **mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation.** *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). (Emphasis added)

Since Eldridge provides no description of how to make the structure of Eldridge Fig. 10k, it is insufficient "mere naming or description of the subject matter."

The Examiner has not shown " if the public was in possession of the claimed invention before the date of invention" by Applicants and thus the Examiner has not made out a prima facie showing that Eldridge is prior art under 35 USC 102. In Applicants' response dated Feb. 24, 2009 Applicants requested that the Examiner

1. as required by 37 CFR104(d)(2) provide documentary evidence that a person of ordinary skill in the art was in possession of how to practice the mere description of Eldridge Col 67, lines 55-59, without relying on Applicants' invention, or
2. as required by 37 CFR 104(d)(2), in the absence of providing g such documentary evidence, to provide and Examiner's affidavit qualifying the Examiner has having sufficient expertise to provide how to practice the mere description of Eldridge Col 67, lines 55-59, without relying on Applicants' invention, or
3. withdraw all the prior art rejections since the Examiner has not made out a prima facie showing that Eldridge is prior art under 35 USC 102 to applicants invention.

Since in the Advisory Action dated 3/20/2009 the Examiner has not proved what was requested in items 1 and 2 above, the Examiner has not established that Eldridge is prior art under 35 USC 102.

In the Advisory Action dated 3/20/2009 at page 2:

- The Examiner states: "[a]s stated in MPEP 2121 1, prior art is presumed to be operable/enabling." This is incorrect. The Examiner does not identify what part of MPEP 2121 1 supports this assertion. There is in fact none.

- The Examiner states: "The burden is on applicant to provide facts rebutting the presumption of operability." The Examiner does not identify what part of MPEP 2121.1 supports this assertion. There is in fact none.
- The Examiner states: "One of ordinary skill in that art would have recognized that the dielectric material could have been applied by a coating process, and would have been capable of performing such a coating process without undue experimentation." Applicants disagree. Since there are no facts to support this assertion by the Examiner, this is a conclusory assertion which cannot provide the missing enabling disclosure in Eldridge. As stated above Applicants requested that the Examiner provide evidence as required by 37 CFR104(d)(2). Since the Examiner has not provided the requested evidence, the Examiner's assertion is unsupported and not a fact. Thus the Examiner has not met his burden to show that Eldridge is prior art to Applicants claimed invention.

CONCLUSION

In view of the remarks herein Applicants request reversal of the rejections under 35 USC 102 and 103 based on Eldridge since it is not prior art under 35 USC 102.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,

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